UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,593	02/27/2002	Daniel J. Rosen	109412.127US2	5752

23483 7590 04/21/2006

WILMER CUTLER PICKERING HALE AND DORR LLP
60 STATE STREET
BOSTON, MA 02109

EXAMINER	
TOMASZEWSKI, MICHAEL	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,593	ROSEN ET AL.	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 2/27/2002. Claims 1-19 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Regarding claim 1, the phrase "in an automated manner" renders the claim indefinite because it is unclear exactly which steps are automated.

(B) Regarding claim 7, the phrase "and/or" renders the claim indefinite because it is unclear how the procedures are determined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 6, 8-9, 11, 15, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkins et al. (5,724,379; hereinafter Perkins).

(A) As per claim 1, Perkins discloses a method comprising:

(1) receiving records of medical procedures (Perkins: abstract; Fig. 1); and

(2) in an automated manner, using a set of expert rules to determine the specialty of physicians by applying the rules to the records of medical procedures (Perkins: abstract; col. 3, lines 27-44; Fig. 1).

(B) As per claim 2, Perkins discloses the method of claim 1, wherein the method includes determining a list of specialties (Perkins: abstract; col. 3, lines 27-44; Fig. 1).

(C) As per claim 6, Perkins discloses the method of claim 1, wherein the determining includes using procedures (Perkins: abstract; col. 3, lines 27-43; Fig. 1).

(D) As per claim 8, Perkins discloses the method of claim 1, wherein the determining includes using diagnoses (Perkins: abstract; col. 3, lines 27-43; Fig. 1).

(E) As per claim 9, Perkins discloses the method of claim 6, wherein the diagnoses are determined by ICD-9 codes (Perkins: abstract; col. 4, lines 16-51; Fig. 1) (Examiner also notes that the use of CPT4 and HCPCS codes to determine procedures is well known and obvious.).

(F) Claims 11, 15, and 17-18 substantially repeat the same limitations as those of claims 1, 6, 8, and 9, respectively, and are therefore, rejected for the same reasons given for those claims and incorporated herein.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3-5, 10, 12-14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins.

(A) As per claim 3, Perkins discloses the method of claim 1, wherein the method includes determining a specialty (Perkins: abstract; col. 3, lines 27-44; Fig. 1).

As per the recitations pertaining to "substituting the determined specialty when the records listed a specialty as internal medicine," and the technique of data substitution in general, it is respectfully submitted that the technique of data substitution and the specialty of internal medicine is well known and obvious. One of ordinary skill in the art would have found it obvious at the time of the invention to incorporate this technique with the motivation of processing data (Perkins: abstract).

(B) As per claim 4, Perkins discloses the method of claim 1, wherein the method includes determining a specialty (Perkins: abstract; col. 3, lines 27-44; Fig. 1).

As per the recitations pertaining to "other than radiology when a specialty in the records is listed as radiology," and the technique of data substitution in general, it is respectfully submitted that the technique of data substitution and the specialty of radiology is well known and obvious. One of ordinary skill in the art would have found it obvious at the time of the invention to incorporate this technique with the motivation of processing data (Perkins: abstract).

(C) As per claim 5, Perkins fails to expressly disclose the method of claim 1, wherein the determining includes using the ages of patients.

Nevertheless, it is respectfully submitted that the technique of determining information through deductive reasoning (e.g., determining a specialty using the age of patients, etc.) is well known and obvious.

One of ordinary skill in the art would have found it obvious at the time of the invention to incorporate this technique with the motivation of processing data (Perkins: abstract).

(D) Claim 10 substantially repeats the same limitations as those of claims 5, 6 and 8 and are therefore, rejected for the same reasons given for claims 5, 6, and 8 and incorporated herein.

(E) Claims 12-14 and 19 substantially repeat the same limitations as those of claims 3, 4, 5, and 10, respectively, and are therefore, rejected for the same reasons given for those claims and incorporated herein.

8. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins as applied to claim 1 above, and further in view of Cave et al. (5,970,463; hereinafter Cave).

(A) As per claim 7, Cave discloses the method of claim 6, wherein the procedures are determined by CPT4 and/or HCPCS codes (Cave: abstract; col. 2, line 44-col. 3, line 60) (Examiner also notes that the use of CPT4 and HCPCS codes to determine procedures is well known and obvious.).

(B) Claim 16 substantially repeats the same limitations as those of claim 7 and is therefore, rejected for the same reasons given for claim 7 and incorporated herein.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a method of customizing a browsing experience on a world-wide-web site (6,734,886); a patient data quality review method and system (5,307,262); a method for computing current procedural terminology codes from physician generated documentation (5,483,443); a system and method for correlating medical procedures and medical billing codes (5,325,293); a method of adjudicating medical claims based on scores that determine medical procedure monetary values (6,879,959); and a personalized health care provider directory (6,014,629).

The cited but not applied prior art also includes non-patent literature articles by Cuesta, IA ("Subspecialty Referrals For Pauciarticular Juvenile Rheumatoid Arthritis" Feb. 2000. Vol. 154, Iss. 2. pg. 122.).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT

C. LUKE GILLIGAN
PATENT EXAMINER